

REMARKS

The Office Action, dated January 9, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1 and 3-31 are currently pending in the subject application, including independent claims 1, 24, and 29-30. In particular, Applicants herein amended claims 1, 3-10, 13-17, 19, 21, and 23-30; and added new claim 31 to more clearly and distinctly claim the subject matter of the present application. It is respectfully submitted that the amendments and claim addition add no new subject matter to the present application and serve only to place the present application in better condition for examination. It is believed that all grounds for rejection in the Office Action are currently addressed and that the present application is currently in condition for allowance in view of the amendment and the following arguments. Entry of the amendments and reconsideration of the rejected pending claims 1 and 3-31 are respectfully requested.

Claim Objections

The Office Action objected to claims 3 and 10 for depending from cancelled claim 2. Applicants herein amend these claims to depend instead from claim 1, which was previously amended to include the limitations of original claim 2. Withdrawal of this objection and reconsideration of these claims are respectfully requested.

Rejection under 35 U.S.C. §101

The Office Action further rejected claim 30 under 35 U.S.C. §101 as being allegedly directed to non-patentable subject matter because the claim currently recites a “computer program.” Although Applicants believe that the recited embodiment represents tangible and useful subject matter that is tangible, Applicants herein have amended claim 30 as suggested in the Office Action to recite a “computer-readable medium.” Applicants believe that this grounds for rejection is moot in view of this amendment, so withdrawal of this rejection and allowance of claim 30 are respectfully requested.

Rejection under 35 U.S.C. §103(a)

Claims 1 and 3-30 were rejected under 35 U.S.C. §103(a) as being allegedly obvious in view of U.S. Patent No. 7,072,329 (Willars) in view of U.S. Published Patent Application Publication No 2003/0214925 (Diaz Cervera). In particular, the Office Action conceded that Willars does not disclose the recitation of conveying transport related information between entities in the asynchronous transfer mode and internet protocol transport networks for controlling the transport bearers in the transport network layer, and alleged that Diaz Cervera cures this deficiency. However, as described in greater detail below, Diaz Cervera is not legally citable prior art under 35 U.S.C §§102/103(a). Since, Willars admittedly does not disclose every limitation of any of the claims, reconsideration and allowance of claims 1 and 3-30 are respectfully requested.

Independent claim 1, from which claims 3-23 depend, relates to a method including configuring an inter-working function, linked with an asynchronous transfer mode transport network and an internet protocol transport network, to use a user defined information element of an existing protocol. The existing protocol is used to establish data transport bearers to adapt a new protocol for controlling the transport bearers in a transport network layer. Then, transport related information is conveyed between entities in the asynchronous transfer mode and internet protocol transport networks for controlling the transport bearers in the transport network layer.

Independent claim 24, from which claims 25-28 depend, relates to an apparatus comprising an inter-working function linked with an asynchronous transfer mode transport network and an internet protocol transport network. The inter-working function includes a mapping entity that is configured to use a user defined information element of an existing protocol, that is used for establishing data transport bearers, to adapt a new protocol for controlling the transport bearers in a transport network layer. The mapping entity is further configured to convey transport related information between entities in the asynchronous transfer mode and internet protocol transport networks for controlling the transport bearers in the transport network layer.

Independent claim 29 relates to an apparatus that includes controlling means for controlling an inter-working function linked with an asynchronous transfer mode transport network and an internet protocol transport network. The apparatus also includes mapping means for using a user defined information element of an existing

protocol for establishing data transport bearers to adapt a new protocol for controlling the transport bearers in a transport network layer. The apparatus also includes conveying means for conveying transport related information between entities in the asynchronous transfer mode and internet protocol transport networks for controlling the transport bearers in the transport network layer.

Independent claim 30 relates to a computer readable medium having computer executable instructions for implementing a method. The method includes configuring an inter-working function linked with an asynchronous transfer mode transport network and an internet protocol transport network to use a user defined information element of an existing protocol. The existing protocol is used to establish data transport bearers to adapt a new protocol for controlling the transport bearers in a transport network layer. Then, transport related information is conveyed between entities in the asynchronous transfer mode and internet protocol transport networks for controlling the transport bearers in the transport network layer.

As conceded in the Office Action and as presented in the prior submitted correspondence, Willars does not disclose every limitation of any of the claims. To address this deficiency in Willars, the Office Action cited to Diaz Cervera.

Applicants respectfully note, however, the Diaz Cervera is not prior art to the present application under 35 U.S.C §102. In particular, Applicants note that Diaz Cervera claims priority to EP02360152.9, which was filed on May 17, 2002. The present application claims priority to Finish Patent Application No. 20011692, filed on August

22, 2001, and this priority has been acknowledged in the Office Action. Therefore, the present application claims an earlier priority date than Diaz Cervera, and therefore Diaz Cervera is not citable prior art against the present application. Consequently, Diaz Cervera cannot be used under 35 U.S.C. §103(a) to cure the admitted deficiencies in Willars.

If new references are presented in a future Office Action to address the below-described and admitted deficiencies in Willars, this new Office Action must be **non-final**.

As noted in the prior correspondence, Applicants submit that each of the above-noted independent claims recites subject matter that is not taught or disclosed by Willars.

For example, as described in FIG. 2A-2C and at Col. 8, line 3, to Col. 19, line 39, Willars generally relates to a multi-layer telecommunications system which includes an application layer and a transport layer. Differing transport technologies are interworked without terminating the application layer signaling or without involving a technology inter-working in the control plane of the application layer (e.g., without interworking in the application signaling). For example, the application layer may be a radio network layer of a wireless telecommunications system. A transport layer interworking function may be situated on an interface between two nodes of the radio access network (RAN). The interworking function can be located in a separate node which may be a node having both ATM and internet protocol (IP) interfaces.

In particular, in Figure 9B, Willars discloses using a Served User Transport (SUT) information element between an inter-working function and an ATM node in order to

deliver the IP-address of an IP node to the inter-working function. Willars fails to teach or suggest using the SUT between the IP node and the inter-working function.

Claim 1 recites, in part, that a user-defined information element is used to convey transport related information between entities in ATM and IP transport networks for controlling the transport bearers in the Transport Network Layer, and Willars does not disclose these recited elements of claim 1. In particular, as described above, Willars discloses that the SUT information element may be used between an inter-working function and an ATM node, but fails to teach or suggest using the SUT between the IP node and the inter-working function.

Therefore, claim 1 continues to be allowable over Willars. Withdrawal of this rejection of claim 1 and reconsideration of this claim in view of the arguments are again respectfully requested. Likewise, claims 3-23 depend from claim 1 and should be allowable over Willars on similar grounds.

Independent claim 24, although different in scope from claim 1, continues to recite similar limitations related to conveying transport related information between entities in ATM and IP transport networks for controlling the transport bearers in the Transport Network Layer. Thus, independent claim 24 also continues to be allowable over Willars. Claims 25-28 depend from claim 24 and continue to be allowable over Willars on similar grounds.

Similarly, independent claims 29 and 30, although different in scope from claims 1 and 24, contain similar recitations related to conveying transport related information

between entities in ATM and IP transport networks for controlling the transport bearers in the Transport Network Layer. Thus, claims 29 and 30 also continue to be allowable over Willars. New claim 31 should likewise be allowed on similar grounds.

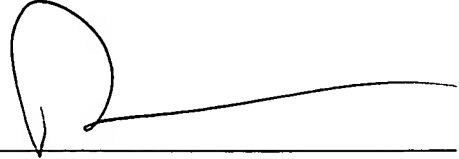
In summary, since Diaz Cervera is not citable prior art and Willars by itself does not disclose each and every recited element of the claims 1 and 3-31, this rejection is clearly improper and should be withdrawn. In view of the arguments presented herein, reconsideration and allowance of claims 1 and 3-31 are respectfully requested.

As discussed above, each of the pending claims 1 and 3-30, including independent claims 1, 24, 29 and 30, recites subject matter which is neither disclosed nor suggested in the Willars. Applicants submit that the recited subject matter is more than sufficient to render the invention non-obvious to a person of ordinary skill in the art. It is respectfully requested that independent claims 1, 24, 29 and 30 and the related dependent claims be allowed in view of the above arguments, comments, and remarks and that the present application be allowed to pass to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'David D. Nelson', written over a horizontal line.

David D. Nelson
Registration No. 47,818

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

DDN/cqc

Enclosures: Additional Claims Transmittal
Check No. 018524